

## **I. The Claims Read Correctly**

Claim 39 was objected to for use of the phrase “at a time certain”. It is respectfully submitted that the phrase “at a time certain” in claim 39 does not contain a typographical error and is a proper use of the phrase. Reconsideration and withdrawal of this objection is respectfully requested.

## **II. The Champion Patent Does Not Anticipate the Claims of the Present Invention**

Claims 1-3, 8, 9, 36, 37, 42, and 43 were rejected as anticipated under 35 U.S.C. §102(e). In support of the rejection, Champion et al. (U.S. Patent No. 5,126,936) was cited. This rejection is respectfully traversed.

Claim 1 recites a “system for enabling a plurality of users to create, manage and trade a portfolio of assets/liabilities via a first plurality of communication links, one to each of the plurality of users, over which each of the plurality of users transmits to the system trading data regarding trades of a plurality of assets/liabilities that each of the plurality of users desires to make”. The recited system includes “receiving user identification information and trading data from each of the plurality of users”.

Claim 30 recites a “personal computer based program for executing on a user's personal computer, for enabling a user to create, manage and trade a portfolio of assets/liabilities and for interfacing with a system for managing a plurality of such users via a first communication link over which the user transmits to the system trading data regarding trades of at least one asset/liability that the user desires to make.” The recited program includes “a communication process communicating said user identification information along with any trades of assets\liabilities to be executed to create or modify a user's portfolio to ensure a user's actual portfolio matches a user's desired portfolio to the system as said trading data via the first communication link.”

Claim 36 recites a “method for creating and managing a portfolio of assets or liabilities by performing a plurality of transactions”. The recited method includes “employing ... to select a plurality of assets or liabilities to be transacted in a plurality of transactions by a user” and “aggregating the plurality of transactions...”.

Claim 44 recites an “apparatus for enabling a plurality of users to make periodic investments in a portfolio of securities”. The recited apparatus includes “a processor

receiving data from each of the plurality of users regarding amounts of money to be invested in each user's portfolio".

Claim 47 recites a "method for enabling a plurality of users to make periodic investments in a portfolio of securities". The recited method includes "receiving data from each of the plurality of users regarding amounts of money to be invested in each user's portfolio".

In contrast to the claimed invention, Champion is purportedly directed to a "data processing system for managing a goal directed investment account." Col. 1, lines 5-8. Champion's system does not enable a user to create, manage, or trade a portfolio of assets/liabilities, however. Rather, Champion's user becomes a counter-party to a contract in which the other counter-party – Champion – promises to return the user's deposit adjusted by a user-specified market multiple. Champion might use such deposits to take a position in the market in an attempt to guarantee the sum of all contracts he enters into with the users, but "no such transaction occurs in the account" of the users. Col. 4, lines 27-28. Instead, "[t]he customer's account simply responds to the various markets (stocks, bonds, gold, etc.) as though such transactions had occurred." Col. 4, lines 29-31.

Also, it is not necessary for Champion to take any position in the market to the extent that the positions of the users offset each other. See Col. 5, lines 11-15. Far from buying a portfolio of assets/liabilities on behalf of investors, Champion's system is designed to enable users to avoid the "burdens" that Champion associates with users owning portfolios of assets/liabilities. See Col. 2, lines 57-60.

Accordingly, it is respectfully submitted that Champion does not anticipate independent claims 1, 30, 36, 44, and 47. Furthermore, because these independent claims are not anticipated by Champion, it stands that claims 2-29, 31-35, 37-43, 44-45, and 48-49, each ultimately depending from these allowable claims, are also not anticipated by Champion.

### **III. The Claims Patentably Define The Invention Over Champion Under 35 U.S.C. § 103**

Claims 4-7, 10-35, 38-41, and 44-49 were rejected under 35 U.S.C. 103(a) as being unpatentable over Champion and further in view of official notice of various elements recited in the rejected claims. This rejection is respectfully traversed.

As an initial matter, the use of official notice to support rejection of any claim is respectfully traversed. Citation and provision of a reference that specifically supports the rejection of each claim is respectfully requested. See MPEP ¶ 2144.03.

Considering the remaining cited reference, Champion fails to establish a *prima facie* case of obviousness. "To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations." See MPEP ¶ 2142; *In re Vaeck*, 947 F.2d 488, 20 USPQ 2d 1438 (Fed. Cir. 1991).

As discussed above, Champion does not enable users to create, manage, or trade a portfolio of assets/liabilities. Moreover, there is no teaching or suggestion to modify the data processing system of Champion to do so. In fact, Champion teaches away from such creation, management, or trading of a portfolio of assets/liabilities by stating that "no such transaction occurs in the account" and that it is undesirable for a customer to own such assets/liabilities.

Specifically, in his Background section, Champion states that "[t]he ownership of securities involves restrictions and regulations that may place an additional burden on the investor." Col. 2, lines 56-60. Thus, contrary to the claimed invention, Champion teaches that ownership by customers is an undesirable "burden."

Accordingly, it is respectfully submitted that Champion does not render obvious any of independent claims 1, 30, 36, 44, and 47. Furthermore, because these independent claims are not rendered obvious by Champion it stands that claims 2-29, 31-35, 37-43, 44-45, and 48-49, each ultimately depending from these allowable claims, are also not rendered obvious by Champion.

#### IV. Double Patenting

The Office Action stated that claims 1-49 of this application conflict with claims 1-17, 20-32, 45, 47, 49, 51, 53, 55, 64-71, 79-81, and 92-94 of Application No. 09/139,020 and requires either cancellation of the conflicting claims from all but one application or

maintenance of a clear line of demarcation between the applications.

In accordance with the Office Action, this requirement will be addressed once a notice of allowance is issued for either this application or Application No. 09/139,020.

**V. Consideration of Submitted References is Requested**

On June 9, 2000, Applicant submitted an Information Disclosure Statement and PTO Form 1449 listing and providing 64 references. It is respectfully requested that those references be expressly considered during the prosecution of this application, that the references be made of record therein, and appear in the "references cited" section of any patent to issue therefrom. It is respectfully requested that the next communication to Applicant include a copy of the Form 1449 with the Examiner's initials beside each listed reference.

**CONCLUSION**

It is respectfully submitted that, in view of the foregoing amendments and remarks, the application as amended is in clear condition for allowance. Reconsideration, withdrawal of all grounds of objection and rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. §1.16 or §1.17 to Deposit Account No. 11-0600. The Examiner is invited to contact the undersigned at 202-220-4247 to discuss any matter regarding this application.

Respectfully submitted,

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